

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 2-4 and 8-10 contain allowable subject matter.

In the Official Action, the Examiner rejects claims 1, 5-7, and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,719,763 to Chung et al., (hereinafter “Chung”).

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 102(e) for at least the reasons set forth below. However, independent claims 1 and 5 have been amended to clarify their distinguishing features.

Turning now to the prior art, Applicants respectfully submit that Chung does not disclose a clamping member that is configured to clamp living tissues. Specifically, the grasping/clamping member 8 described in Chung is configured to grasp suture threads, whereas the clamping member recited in claims 1 and 5 are configured to clamp living tissues so that a puncture member can penetrate the living tissues. Therefore, the structure of the claimed endoscopic suture apparatus and function of the clamping member recited in claims 1 and 5 are totally different from that disclosed in Chung.

Independent claims 1 and 5 have been amended to clarify such features. The amendment to claims 1 and 5 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment to claims 1 and 5.

With regard to the rejection of claims 1, 5-7 and 11 under 35 U.S.C. § 102(e), an endoscopic suture apparatus having the features discussed above and as recited in

independent claims 1 and 5, is nowhere disclosed in Chung. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claims 1 and 5 are not anticipated by Chung. Accordingly, independent claims 1 and 5 patentably distinguish over Chung and are allowable. Claims 6, 7, and 11 being dependent upon claim 5, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 5-7 and 11 under 35 U.S.C. § 102(e).

Furthermore, the Examiner rejects claims 1, 5-7, and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9-17 of U.S. Patent No. 6,719,763. In response, Applicants respectfully traverse the Examiner's rejection for at least the same reasons as set forth above. Specifically, Chung does not disclose a clamping member that is configured to clamp living tissues. That is, as discussed above, the grasping/clamping member 8 described in Chung is configured to grasp suture threads, whereas the clamping member recited in claims 1 and 5 is configured to clamp living tissues so that a puncture member can penetrate the living tissues. As discussed above, claims 1 and 5 have been amended to clarify such distinguishing features. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1, 5-7, and 11 under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully request that, at the very least, the Examiner reconsider the double patenting rejection in light of the amended claims.

Lastly, new claims 12-17 have been added to further define the patentable invention. New claims 12-17 are fully supported in the original disclosure. Thus, no new


¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

matter has been entered into the disclosure by way of the addition of new claims 12-17.

Applicants respectfully submit that new claims 12-17 are at least allowable as depending upon an allowable base claim (1 and 5 either directly or through an intervening claim). Claims 6 and 7 have also been amended to correct a grammatical error therein.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,


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